

## **REMARKS/ARGUMENTS**

### **Status of the Application**

Prior to entry of this Amendment, claims 1-73 were pending for examination. This amendment amends claims 1, 4, 5, 9, 15-17, 25, 36-40, 43, 53, and 61-64 and adds new claim 74. Claims 41, 42, 51 and 52 have been canceled. Hence, after entry of this amendment, claims 1-40, 43-50, and 53-74 will stand pending for examination. Claims 1, 4, 5, 9, 18, 25, 36, and 43 are independent claims. The applicant respectfully requests reconsideration of the pending claims, for at least the reasons presented below.

An Office Action mailed March 13, 2008 rejected claims 9-17 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 36-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 1-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2007/0101423 of Oliver et al. (hereinafter "Oliver"); rejected claims 9-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2005/0071748 of Shipp (hereinafter "Shipp"); rejected claims 18-60, and 62-63 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2008/0052359 of Golan et al. (hereinafter "Golan"); rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent Pub. No. 2003/0097409 of Tsai (hereinafter "Tsai") and Shipp; and rejected claims 61, and 64-73 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Golan and Oliver.

### **Notice of Non-Compliant Amendment**

A Notice of Non-Compliant Amendment mailed December 10, 2008 states that Applicant's Remarks are inconsistent with the claim listing because the remarks state that claims 1-73 will stand pending for examination. Appropriate correction has been made herein to state that claims 1-40, 43-50, and 53-74 will stand pending for examination.

The Notice further states that the Examiner is confused by Applicant's September 12, 2008 submission of an "Appendix" as it appears to be unrelated to the case at hand and fails to appear in any remarks or IDS to suggest why it has been included, and therefore requests that

a short description of its relation to the case at hand and the reasons for which it has been submitted for consideration be provided. This Appendix (which is also included with the Applicant's present response) includes a copy of provisional U.S. Application No. 60/517,868 (referred to below as the "Golan Provisional"). This copy is provided merely for the convenience of the Examiner, as the remarks below discuss the disclosure of this application.

### **Claim Amendments**

Claims 1, 4, 5, 9, 15-17, 25, 36-40, 43, 53, and 61-64 have been amended herein. Claim 1 has been amended to recite, inter alia, "wherein the instructions executable to investigate the uniform resource locator comprise instructions to: download at least one web page from the server referenced by the uniform resource locator; and analyze the at least one web page to determine whether the at least one web page comprises a data collection mechanism for allowing a user to provide personal information to the server referenced by the at least one uniform resource locator." Claims 5, 25, and 36 have been amended in similar fashion. Somewhat similarly, claim 4 has been amended to recite, inter alia, "wherein investigating the uniform resource locator comprises: downloading at least one web page from the server referenced by the uniform resource locator; and analyzing the at least one web page to determine whether the at least one web page comprises a data collection mechanism for allowing a user to provide personal information to the server referenced by the at least one uniform resource locator." Claim 43 has been amended in similar fashion. Support for these amendments can be found throughout the application, including, inter alia, in original claim 12 and the portions of the specification supporting that claim.

Claim 9 has been amended to replace the term "address the uniform resource locator appears to reference" with the term "address the uniform resource locator purports to reference but actually does not reference." It is submitted that this amendment does not narrow the scope of claim 9. Support for this amendment can be found throughout the application, including inter alia, at paragraph 0085 of the application.

Claim 36 has been amended to recite "[a] computer readable medium comprising a computer software application including instructions that are executable by a computer."

Support for this amendment can be found throughout the application, including in particular in original claim 36, as well as at, inter alia, at paragraphs 0015, 0016, 0020, 0023, and 0067-69.

Claims 15-17, 37-40, 53, and 61-64 have been amended for consistency with the independent claims from which they depend.

New claim 74 has been added. Support for the new claims can be found throughout the application, including, inter alia, paragraph 0092.

### **35 U.S.C. § 112 Rejections**

The Office Action has rejected claims 9-17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the office action noted that Applicant's claims are replete with the phrases "apparent address," "appears to reference," and "apparently referenced," all of which call to question what actually is being referenced, if anything at all. Claim 9 has been amended, as indicated above, to replace the term "address the uniform resource locator appears to reference" with the term "address the uniform resource locator purports to reference but actually does not reference." It is believed that this amendment, while not changing the scope of claim 9, more clearly sets forth the functionality described in that claim. Claims 10-17, which depend from claim 9, have been amended as necessary for consistency with the amendments to claim 9.

It is believed that these amendments overcome the rejections under § 112, and that claims 9-17, at least as amendment, clearly and distinctly set forth the subject matter regarded as the invention covered by those claims. Reconsideration of the amended claims is respectfully requested.

### **35 U.S.C. § 101 Rejection, Non-statutory matter**

The Office Action has rejected claims 36-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. These rejections are respectfully traversed in part, and it is believed that the rejections have been overcome in part. Claim 36 has been amended to recite a "computer readable medium comprising a software application including instructions that are

executable by a computer." At least as amended, claim 36 is directed to an article of manufacture, indisputably one of the statutory categories of invention covered by § 101.

As grounds for the § 101 rejections, the Office Action asserts that claim 36 "includes no tangible result." The applicants respectfully disagree. Specifically, claim 36 recites "instructions that are executable by a computer to . . . prepare a report comprising at least some of the information about the server hosting the web site referenced by the uniform resource locator." This report is, itself, a useful, tangible, and concrete result. Accordingly, at least as amended, claim 36 (and claims 37-42, which depend therefrom and have been amended for conformance with claim 36) are believed to be allowable under § 101, and reconsideration of the amended claims is respectfully requested.

### **The Golan Reference**

As an initial matter, the Office Action relies extensively on Golan in rejecting many of the pending claims (including, for example, claims 18-63) under §§ 102 and/or 103. It is respectfully submitted that the Office's reliance on Golan is misplaced. Golan is a national phase application of PCT/US04/36993 (the "Golan PCT"), which was filed November 8, 2004, well after the filing date of the present application. The Golan PCT, however, claims priority from provisional U.S. Application No. 60/517,868 (the "Golan Provisional"), which was filed prior to the filing date of the present application.

Nonetheless, the Golan Provisional (a copy of which has been provided herewith in Appendix A) lacks much of the disclosure of the Golan PCT, including much of the disclosure cited by the Office Action as teaching the elements of the pending claims, and it is respectfully submitted that, to the extent the Golan Provisional fails to disclose elements of the pending claims, the Office properly cannot apply the Golan PCT against the claims of this application. Moreover, as described further below, the Golan Provisional fails, either alone or in combination with any other cited reference, to teach or suggest each element of any pending claim. Accordingly, the applicants respectfully request reconsideration of all rejections in which Golan is applied.

**35 U.S.C. §§ 102 and 103 Rejections**

The Office Action has rejected claims 1-73 under 35 U.S.C. §§ 102(e) and/or 103(a) as being anticipated by and/or unpatentable over various combinations of Golan, Oliver, Shipp, and Tsai (collectively, the "Cited References"). It is respectfully submitted that the claims, at least as amended, are allowable over any combination of the Cited References, because no combination of those references teaches each element of any pending claim.

**1. Claims 1, 4, 5,, 25, 36, and 43**

Consider, for example, claim 1, which recites, inter alia, "wherein the instructions executable to investigate the uniform resource locator comprise instructions to: download at least one web page from the server referenced by the uniform resource locator; and analyze the at least one web page to determine whether the at least one web page comprises a data collection mechanism for allowing a user to provide personal information to the server referenced by the at least one uniform resource locator." None of the cited references teach these elements.

Of note, original claim 12 recites elements similar to those quoted above, and the Office Action asserts that paragraphs 0029-33 of Shipp teach such elements. A thorough review of Shipp, however, reveals that neither the cited paragraphs nor anything else in Shipp teach these elements. Paragraphs 0029 and 0030 of Shipp do mention that "external objects" (which admittedly could include web pages) are downloaded and "scanned for pornography, viruses, and other undesirables" as well as "analyzed to see whether they contain external links." This disclosure, however, fails to teach or suggest any analysis that might "determine whether the at least one web page comprises a data collection mechanism for allowing a user to provide personal information." In fact, scanning for pornography or viruses is a quite different process than analyzing fields (and other data collection mechanism) on a web page to determine whether the page is designed to collect personal information. Indeed, Shipp purports only to disclose "a method of, and system for, replacing external links in electronic documents such as email with links which can be controlled," Shipp, ¶ 0001, and Shipp therefore provides nothing that would lead one of skill in the art to believe that Shipp's system might be modified to analyze fields and other data collection mechanisms on a web page (if such a modification were even possible).

The Office Action fails to assert (and a review of the Cited References does not reveal) any teaching or suggestion in any of the other Cited References that might teach or suggest this combination of elements. Accordingly, for at least this reason, claim 1 is believed to be allowable over any combination of the Cited References. Independent claims 4, 5, 25, 36 and 43 each recite similar elements and are believed to be allowable for at least similar reasons.

## **2. Claim 9**

Claim 9 also is believed to be allowable over any combination of the Cited References. The Office Action rejected claim 9 under § 102(e) as being anticipated by Oliver and under § 102(e) as being anticipated by Shipp. Neither of these references, however teach every element of claim 9.

For example, claim 9 recites, inter alia, instructions executable to "obtain information about an address the uniform resource locator purports to reference but actually does not reference" and "compare the ascertained address [of the server actually referenced by the uniform resource locator] with the information about the address the uniform resource locator purports to reference." Neither Shipp nor Oliver, nor the combination of the two, discloses these elements.

While Oliver (¶¶ 0014-16) does disclose the concept of misleading URLs, Oliver never teaches or even suggests that the address (e.g., IP address) of the server actually referenced by the URL might be compared with information about the address the URL purports to reference. Rather, the system disclosed by Oliver merely examines the URL itself for internal indicators (e.g., the "@" in the URL discussed in paragraph 0014 of Oliver) and/or searches databases of whitelisted (known good) or blacklisted (known bad) URLs (reference points). The invention of claim 9 provides a more sophisticated process, in which the URLs themselves are investigated (including, as recited by dependent claim 12, by download and analysis procedures similar to those discussed above with respect to claim 1), providing a more reliable indication of likely fraud than mere examination of the URL format itself or resort to a white/black list. Hence, Oliver fails to teach or suggest the elements of claim 9, and claim 9 is believed to be allowable over Shipp for at least this reason.

Likewise, Shipp fails to anticipate claim 9. As an initial matter, the Office Action cites paragraphs 0007-09 and 0025 as teaching the elements of both "ascertain[ing] an address associated with a server referenced by the uniform resource locator" and "obtain[ing] information about an address the uniform resource locator purports to reference but actually does not reference." These paragraphs of Shipp merely teach the concept of "following a link," and so possibly might be read to teach "ascertain[ing] an address associated with a server referenced by the uniform resource locator." They clearly, however, fail to teach or even remotely suggest "obtain[ing] information about an address the uniform resource locator purports to reference but actually does not reference." Indeed, Shipp does not even mention the concept that a URL might purport to reference an address different from the one it actually references. It is believed that perhaps the amended language in claim 9 might highlight these distinctions more clearly than the previous language.

Moreover, the Office Action's citation of paragraph 0041 (as teaching compare[ing] the ascertained address associated with the information about the address the uniform resource locator purports to reference is inapposite," recited by claim 9) is inapposite. Paragraph 0041 discusses the link-replacement feature of Shipp's system, which has nothing to do with comparing the actual address referenced by the URL with the address the URL purports to reference. Shipp's procedure is designed to redirect users to a "safe" version of the referenced object. On the other hand, the point of the comparison in claim 9 is "determine whether the uniform resource locator is fraudulent." The link replacement technique of Shipp provides no such comparison, nor any basis to determine whether a URL is fraudulent.

Accordingly, Shipp also fails to teach or suggest each element of claim 9. Moreover, since Shipp and Oliver both fail to teach the same element(s), their combination also would not successfully teach the elements of claim 9. Hence, claim 9 is believed to be allowable over any combination of Shipp, Oliver, and any of the other Cited References.

### **3. Claim 18**

The Office Action rejected claim 18 under § 102(e) as being anticipated by Golan. As noted above, however, Golan only serves as prior art to the extent that the Golan Provisional

teaches each element of claim 18. It is respectfully submitted that the Golan Provisional does not do so. For instance, the Golan Provisional fails to teach, inter alia, either "download[ing] a web page from a suspicious server," "pars[ing] the web page to identify at least one field into which a user may enter personal information," or "analyz[ing] the at least one field to identify a type of information requested by the at least one field." While the Golan Provisional (p. 7) does disclose the concept of "filling [a Phishing website] with fake records of people," this disclosure falls far short of teaching the quoted elements of claim 18. (As an aside, it is believed that Golan itself may fail to provide such teaching, but because the Golan Provisional omits such disclosure, the content of Golan itself is immaterial.) Accordingly, for at least this reason, claim 18 is believed to be allowable over Golan and all of the other Cited References, whether taken alone or in combination.

#### **4. Dependent Claims**

Each of the remaining claims ultimately depend on one of the independent claims discussed above, and the dependent claims are believed to be allowable at least by virtue of their dependence from allowable base claims. Moreover, many of the dependent claims recite additional novel features and are independently allowable based on those recited features.

Merely by way of example, claim 19 recites "analyzing the at least one field to identify a type of information requested by the field comprises interpreting a label associated with the at least one field." Neither the Golan Provisional nor Golan itself teaches or suggests this type of analysis, and claim 19 therefore is allowable over Golan for this additional reason.

#### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.



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